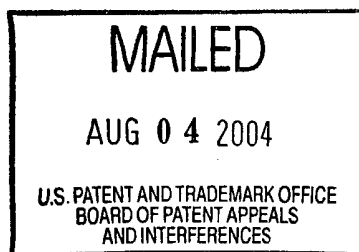


The opinion in support of the decision being entered today
was not written for publication and is not binding
precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT PATRICK HOF,
PETRUS JOHANNES HERMSEN and RONUS DE BODE



Appeal No. 2004-0971
Application No. 09/887,933

ON BRIEF

Before WALTZ, KRATZ, and PAWLIKOWSKI, Administrative Patent
Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134
from the examiner's final rejection of claims 12 through
22.

Claim 12 is representative of the subject matter on
appeal, and is set forth below:

12. A process for racemising an enantiomer-enriched
Schiff base of a primary amide of an amino acid which
process comprises contacting said enantiomer-enriched
Schiff base of a primary amide of an amino acid with a
strong base in an organic solvent,

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wherein said strong base is chemically reactive with water.

The examiner relies upon the following reference as evidence of unpatentability:

Hijiya et al. (Hijiya) 5,679,857 Oct. 21, 1997

Claims 12 through 22 stand rejected under 35 U.S.C. § 103 as being obvious over Hijiya.

OPINION

In the paragraph bridging pages 3 and 4 of the Brief, appellants argue that there is no teaching or suggestion in Hijiya of the racemization of a Schiff base of a *primary* amide of an amino acid.¹ Appellants argue that Hijiya discloses racemization of a Schiff base of a *secondary* amino acid amide. On page 4 of the Brief, appellants argue that Hijiya does not provide a suggestion or motivation to modify the secondary amino acid amides to arrive at the primary amino acid amides used in the claimed invention. On page 5 of the Brief, appellants also argue that there is no indication of why a skilled artisan would expect that a primary amide of an amino acid would function equivalently in the teachings of Hijiya. See also pages 2-3 of the Reply Brief.

¹ The examiner agrees that Hijiya does not teach a primary amide of an amino acid. Answer, page 3.

In response, on page 5 of the Answer, the examiner states that the claims are directed to a process. The examiner states that the process of Hijiya is an analogous process. The examiner states that appellants have argued and admitted that Hijiya teaches a genus of an amino acid amide.² The examiner states that this genus consists of only three species, primary, secondary, and tertiary amide. The examiner states that "[s]election of three species from one genus is well within the ordinary skill in the art for the process, without undue experimentation, especially when there is a chiral center present". Answer, page 5.

Because the examiner has not demonstrated that Hijiya teaches a genus of an amino acid amide, the examiner's premise that "selection of three species from one genus" would have been obvious, is not supported by the facts of record. We emphasize that the examiner's statement of the rejection made on page 3 of the Answer does not point to any disclosure in Hijiya that teaches a genus. See, also, footnote 2.

² The examiner does not point to a location in the Brief where appellants admit that Hijiya discloses a genus. In fact, we observe that on page 4 of the Brief, appellants state "[e]ven for the sake of argument Hijiya teaches a genus of amino acid amides . . . ". This is not an admission by appellants that Hijiya teaches a genus. At best, appellants acknowledge that Hijiya teaches a secondary amino acid amide. The examiner does not point to any disclosure in Hijiya that a genus of an amino acid amide is taught.

Furthermore, the examiner has not provided any factual basis that one of ordinary skill in the art would have reasonably expected a primary amide to possess the same function/properties of a secondary amide in appellants' claimed process. On the other hand, appellants discuss in detail, on pages 3-4 of the Reply Brief, how "not all amides are created equal".

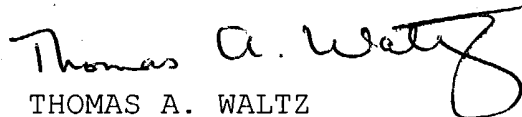
We note that the initial burden of presenting a prima facie case of unpatentability on any ground rests with the examiner. See In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). We also note that in order for a prima facie case of obviousness of the claimed invention to be established, the prior art as applied must be such that it would have provided one of ordinary skill in the art with both a suggestion to carry out appellants' claimed invention and a reasonable expectation of success in so doing. See In re Dow Chem. Co., 837 F.2d 469, 473, 5 USPQ2d 1529, 1531 (Fed. Cir. 1988). "Both the suggestion and the expectation of success must be founded in the prior art, not in the applicant's disclosure." Id.

In the instant case, as pointed out by appellants on pages 4-5 of the Reply Brief, the examiner has, at best, offered an "obvious to try" standard, which is insufficient to support a prima facie case. See, In re Geiger, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278; cf. In re Wesslau, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965).


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In view of the above, we reverse the rejection.

REVERSED


THOMAS A. WALTZ
Administrative Patent Judge


PETER F. KRATZ
Administrative Patent Judge


BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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